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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,991	12/06/2001	Yuuji Saiki	020606	3509

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EXAMINER

LAVARIAS, ARNEL C

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/015,991

Applicant(s)

SAIKI ET AL.

Examiner

Arnel C. Lavarias

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 17-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendments to the specification and abstract of the disclosure in Paper No. 7, dated 6/30/03, are acknowledged and accepted. In view of these amendments, the objections to the specification in Section 3 of Paper No. 6, dated 4/15/03, are respectfully withdrawn.
2. The amendments to Claims 1-2, 4-5, 7, 13-15 in Paper No. 7, dated 6/30/03, are acknowledged and accepted. In view of these amendments, the objections to the claims in Section 4 of Paper No. 6, dated 4/15/03, are respectfully withdrawn.
3. The addition of Claims 16-26 in Paper No. 7, dated 6/30/03, are acknowledged and accepted.
4. In view of the addition of claims above, restriction of the claims is required as follows.

### ***Election/Restrictions***

5. Newly submitted Claims 17-26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:  
  
Species I- drawn to an optical member including a protective film, wherein the protective film comprises a protective base and an adhesive layer disposed on the protective base so that the protective base can be released together with the adhesive layer from the optical material. Claims 1-4, 9-12.

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Species II- drawn to an optical member including a protective film, wherein the optical member comprises a polarizing plate having a transparent protective layer on one or both faces of a polarizing film, and the protective film is disposed on the transparent protective layer of the polarizing plate. Claims 17-23.

Species III- drawn to an optical member including a protective film, wherein a reflecting layer having a fine undulating structure is disposed on the protective film. Claims 24-26.

Currently, Claims 5-8, 13-16 are generic among Species I, II, and III.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in

the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Since the Applicants have received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 17-26 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Response to Arguments*

6. The Applicants argue that Saiki '010 and Saiki '181 were both improperly cited under 35 U.S.C. 102(a) as not being "by another". The Examiner disagrees. The Examiner notes that the submitted Declaration by the inventors do not list the Saiki '010 or Saiki '181 references, although it is noted that these documents are derived from the Japanese applications listed. Also, the Examiner notes that although the last name of the fourth inventor may have been misspelled (Shoda vs. Shouda), the first name does not match at all (Takamori vs. Takashi). If these are one and the same, a signed declaration by the fourth inventor stating such would obviate the above rejections under 35 U.S.C. 102(a).
7. Applicant's arguments with respect to Claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.
8. Claims 1-16 are rejected as follows.

*Claim Objections*

9. Claim 12 is objected to because of the following informalities:

Claim 12 recites the limitation "the separator" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested that "the protective film" be used instead.

Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-4, 9-12 are rejected under 35 U.S.C. 102(a) as being anticipated by Saiki et al. (JP2000-347010A or Saiki '010), of record.

Saiki '010 discloses an optical member (See Figures 1-3) in which a surface of an optical material (See 2 in Figures 1-3) is bonded to and covered with a protective film (See 1 in Figures 1-3) having an outer surface roughness Ra of at least 0.03  $\mu\text{m}$  (See Abstract), wherein the protective film comprises a protective base and an adhesive layer disposed on the protective base so that the protective base can be released together with the adhesive layer from the optical material (See Paragraphs 0027-0037). Saiki '010

additionally discloses the protective film being disposed on one surface of the optical material (See 1 and 2 in Figures 1-3), a separator being provided on the other surface of the optical material via an adhesive layer (See 4 in Figures 1-3), the optical material comprising a polarizing plate and at least one of a retardation plate and a brightness enhancement plate (See for example 5 and 6 in Figures 2-3), and a liquid display having the optical member (See paragraph 0002).

12. Claims 5-8, 13-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Saiki et al. (JP2000-347181 or Saiki '181), of record.

Saiki '181 discloses an optical member (See Figures 1-3) in which an adhesive layer (See 2, 21, 22 of Figures 1-3) disposed on an outermost surface of an optical material (See 3 in Figures 1-3) is provisionally bonded to and covered with a separator (See 1 in Figures 1-3) having an outer surface roughness Ra of at least 0.03  $\mu\text{m}$  (See Abstract).

Saiki '181 additionally discloses the separator being disposed on one surface of the optical material (See 1 and 3 in Figures 1-3), a protective film being provided on the other surface of the optical material (See 4 in Figures 1-3), the optical material comprising a polarizing plate and at least one of a retardation plate and a brightness enhancement plate (See for example 5 and 6 in Figures 2-3), and a liquid display having the optical member (See paragraph 0002).

13. Claims 1, 3, 9-12 are rejected under 35 U.S.C. 102(a) as being anticipated by Sumi (JP2001-030427).

Sumi discloses an optical member (See Paragraphs 0002-0003) in which a surface of an optical material (See Paragraphs 0002-0003) is bonded to and covered with a

protective film (See Paragraphs 0002-0003) having an outer surface roughness Ra of at least 0.03  $\mu\text{m}$  (See Paragraphs 0008), wherein the protective film comprises a protective base and an adhesive layer disposed on the protective base so that the protective base can be released together with the adhesive layer from the optical material (See Paragraphs 0002-0003; 0032-0033). Sumi additionally discloses the protective film being disposed on one surface of the optical material (See for example Abstract; Paragraph 0002-0003, 0032), the optical material comprising a polarizing plate (See Paragraph 0057), and a liquid display having the optical member (See Paragraph 0057).

### *Claim Rejections - 35 USC § 103*

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi in view of Kameyama et al., of record.

Sumi discloses the invention as set forth above in Claim 1, except for a separator being provided on the other surface of the optical material via another adhesive layer, or the optical material additionally comprising at least one of a retardation plate and a brightness enhancing plate. It is well known in liquid crystal display technology to utilize both retardation plates and brightness enhancing plates in liquid crystal displays, as well as to provide a separator with another adhesive layer on one side of the optical



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material. For example, Kameyama et al. teaches a typical liquid crystal display with an optical member (See Figure 7), wherein the optical material comprises a polarizing plate and at least one of a retardation plate and a brightness enhancing plate (See Abstract), and the use of pressure sensitive adhesive layers on a separator treated with a release layer for forming an optical element comprising superposed and united layers (See col. 15, lines 1-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a separator be provided on the other surface of the optical material via another adhesive layer, or the optical material additionally comprise at least one of a retardation plate and a brightness enhancing plate, as taught by Kameyama et al., in the optical material of Sumi, for the purpose of 1) providing additional contrast adjustment by altering the polarization state of the light propagating through the optical material, and 2) provide a means of protecting the underlying adhesive layer and optical material when the optical material is not ready for installation and use.

16. Claims 5-7, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwata (U.S. Patent No. 6111699).

Iwata discloses an optical member (See for example Figures 6B, 7, 11) in which an adhesive layer (See 34 of Figure 6B) disposed on an outermost surface of an optical material (See 12 in Figure 6B) is provisionally bonded to and covered with a separator (See 36 in Figure 6B). Iwata additionally discloses the separator being disposed on one surface of the optical material (See Figures 6B, 7), a protective film being provided on the other surface of the optical material (See 18, 32 in Figures 6B) having an outer

surface roughness Ra of at least 0.03  $\mu\text{m}$  (See Abstract; col. 5, lines 50-65), the optical material comprising a polarizing plate and at least one of a retardation plate and a brightness enhancement plate (See for example 42 in Figure 7; 86 in Figure 11), and a liquid display having the optical member (See for example col. 10, line 25-32). Iwata lacks the separator also having an outer surface roughness Ra of at least 0.05 to 5  $\mu\text{m}$ . It would have been obvious to one having ordinary skill in the art at the time the invention was made to also have the separator have an outer surface roughness Ra of at least 0.05 to 5  $\mu\text{m}$  to prevent the separator portion of the optical member from sticking to adjacent optical members since such surface roughness treatments are similarly used to prevent the polarizing plate portion of the optical member from similarly sticking to adjacent optical members, as well as avoid problems of stiction during manufacturing processes.

### *Conclusion*

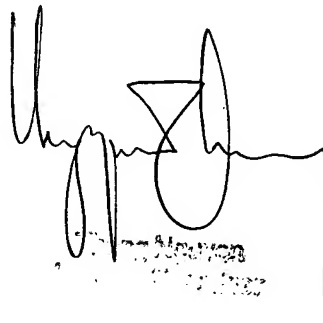
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 703-305-4007. The examiner can normally be reached on M-F 8:30 AM - 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 703-305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

Arnel C. Lavarias  
8/18/03

A handwritten signature in black ink, appearing to read 'Arnel C. Lavarias', with a stylized, looped flourish at the end.